UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/705,367 | 11/10/2003 | Tetsuya Yoshioka | P1266US | 4333 |

1218 7590 03/03/2009

CASELLA & HESPOS
274 MADISON AVENUE
NEW YORK, NY 10016

| EXAMINER | |
|---|---|
| LETT, THOMAS J | |
| ART UNIT | PAPER NUMBER |
| 2625 | |
| MAIL DATE | DELIVERY MODE |
| 03/03/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/705,367 | YOSHIOKA ET AL. | |
| | Examiner | Art Unit | |
| | THOMAS J. LETT | 2625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *15 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1. Applicants' arguments filed 15 December 2008 have been fully considered but they are not persuasive.

2. Applicants' argument persists that the serial transmission mode according to claim 1 sends plural image data corresponding to a plurality of document sets. Accordingly, the N documents/pages in the real time transmission mode of Kuwahara et al. pointed out by the Examiner correspond to the single document set formerly of claim 1, and the transmission of a single document set upon a one time designation of the recipient corresponds to the single transmission mode according to claim 2 of individually sending single image data read from a single document. Therefore, Kuwahara et al does not disclose the serial transmission mode according to claim 1.

3. Examiner responds that Kuwahara et al clearly teaches real-time transmission where each page of the documents (i.e., plural image data) are scanned and immediately delivered to a recipient, see at least col. 1, lines 52-54 and "No" at decision box 406 of figure 4. Examiner has already explained (or analogized) that if a user of Kuwahara et al sets N **documents** (let N = 6 documents) on a feeder, or manually feeds N documents, real-time transmission immediately sends each of the 6 documents to the same user upon a one time designation. This is a serial mode of transmission where each page is immediately sent and each document is immediately sent to a user upon a one-time designation.

4. Applicant states that according to Wiley, a designation of a recipient is executed once. However, as shown in FIGS. 2-5, but plural recipients (plural destinations) are designated, and if a single document set is sent to the plural recipients, a single document set is converted into a different format for each recipient, and a different transmission process (email, facsimile, and

etc.) is executed for each recipient. In other words, Wiley designates plural recipients by a one time designation, but then a single document set having the same content is sent in a parallel to a plurality of recipients, i.e., plural apparatuses (for example, computer and facsimile). Of course Wiley can designate one recipient by one time designation. In this situation, a single document is converted into a format suitable for one recipient, and a single document set is transmitted by one time transmission process.

5. Examiner responds that if 6 documents are placed on the input feeder, and the user of Wiley designates a recipient, the plurality of documents is serially sent to a user. If the user of Wiley has to send a document to several recipients, then a single document set is converted into a different format for each recipient, and a different transmission process (email, facsimile, and etc.) is executed for each recipient.

6.

***Claim Objections***

7. The claim language remains conflicting and/or ambiguous. Applicants continue to claim that a reading means reads an image (line 3 of claim 1) to generate image data, which conflicts with, image data is read by said reading means (line 6-7 and line 9-10 and line 5 of claim 7). Applicants also state that an image of a document is read (line 3 of claim 1) but then also states that the plurality of document sets is read by said reading means (line 14). Appropriate correction is required.

8. To help Examiner understand claim 1, it would also be useful to point Examiner to the disclosure teaching a (1) reading means for reading an image (i.e., one image) of a document (i.e., one document) to generate image data corresponding to a single document set, and (2) reading means for reading **an image** (i.e., one image) of a document (i.e., one document) to generate **plural image data corresponding to a plurality of document sets**. Examiner

understands, based on para. 0073, that a single document set is read and as a result, single image data is generated which would support item (1). When the user manually repeats steps S2 and S3, the transmission mode can be repeated. Now, Examiner understands, based on para. 0047, that a plurality of document sets must be read from a plurality of document sets, except the claim language corresponding to item (2) is not constructed as such. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwahara et al (USPN 6,894,799 B2) in view of Wiley (US Pub 20030081234 A1).

Regarding claim 1, Kuwahara et al disclose an image reading apparatus (facsimile machine F, see figure 1), comprising:

reading means (scanner 11, col. 3, lines 33-34) for reading an image of a document to generate image data corresponding to a single document set and to generate plural image data corresponding to plural document sets (image data is scanned and generated, col.3, lines 36-38);

recipient designating means (automatic dialing unit 2, col. 3, lines 16-17) for designating a recipient to which the image data read by said reading means is sent via the network in response to a manipulation by a user; and

transmitting means (automatic dialing unit 2, col. 3, lines 16-17 with NCU 3) for transmitting the image data read by said reading means to the recipient designated by said recipient designating means; and

operating means for allowing the user to enter an operation command to the image reading apparatus and including a start key (control panel 10 starts the transmission of image data to a recipient after necessary data is entered by a user, col. 4, line 62 – col. 5, line 4; operator can also enter a time for transmission of document(s), col. 3, line 46 and col. 5, lines 62-64),

wherein said transmitting means serially sends plural image data (plurality of image data, col. 3, lines 47-48) corresponding to the plurality of document sets read by said reading means to the same recipient upon a one time designation of the recipient by said recipient designating means by a plurality of transmission processes (there are several transmission processes available to Kuwahara et al in a serial transmission mode (real-time transmission where each of the pages of the documents (i.e., plural image data) are scanned and immediately delivered to a recipient, see at least col. 1, lines 52-54) of serially sending each of the plurality of document sets separately by repeating the image reading by said reading means and the image data transmission by said transmitting means without the designation of the recipient by said recipient designating means in response to the depressing the start key in the serial transmission mode (If a user sets N documents on a feeder or manually feeds N documents, the document sets will be read repeatedly and sent to a user upon a one-time designation. Real-time transmission immediately sends each of the stored documents. This is a serial mode of transmission where each document is immediately sent and the user only has to designate a recipient once. Kuwahara et al do not have to designate a recipient as each page is scanned. The user of Kuwahara et al can also repeat the scanning and transmitting

much like Applicants' repeat of steps S2 and S3. The box administration also retains the address of the recipient for subsequent transmission, see figure 3).

Kuwahara et al do not expressly disclose that the image reading apparatus is so configured as to render image data transmittable to a device via a predetermined network.

Wiley teaches that image data may be sent to different network types such as fax, email, printer, copier, etc., see at least para. 0016 and figures 2 through 5. Of note, but not relied upon by Examiner, is that Wiley teaches a reading means (imaging bed 103) for reading an image of a document to generate image data corresponding to a single document set (electronic document 120) and to generate plural image data corresponding to plural document sets (plural paper documents 110 can obviously be made into a plurality of electronic document images 120) to the same recipient upon a one time designation of the recipient by said recipient designating means (see figures 2 through 5) by a plurality of transmission processes (email, fax, etc.);

recipient designating means (interface 200, see at least para. 0021 and para. 0033) for designating a recipient (see para. 0034 and figures 2 through 5) to which the image data read by said reading means is sent via the network in response to a manipulation by a user

Kuwahara et al and Wiley are analogous art because they are from the similar problem solving area of image transmission. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the diverse selection of network choices feature of Wiley to the device of Kuwahara et al in order to obtain a device capable of designating a network. The motivation for doing so would be to expand the transmission options of a image sending device.

Regarding claim 2, Kuwahara et al disclose an image reading apparatus according to claim 1, further comprising

setting means (display 9, see figure 6) for selectively setting either one of said serial transmission mode (real-time transmission where each page of the documents (i.e., plural image data) are scanned and immediately delivered to a recipient, see at least col. 1, lines 52-54) and an individual transmission mode (delayed transmission function, col. 3, lines 43-46) of individually sending single image data corresponding to a single document set (single document, col. 3, lines 43-45) in response to a manipulation by the user (selection of delayed transmission function), wherein said transmitting means serially sends (via selection of batch transmission function) plural image data corresponding to plural document sets read by said reading means to the recipient designated by said recipient designating means if the serial transmission mode is designated by said setting means, and wherein said recipient designating means designates the recipient to which the image data is sent via the network in response to a manipulation by the user with respect to each image data read by said reading means, and said transmitting means individually sends said each image data read by said reading means to the recipient designated by said recipient designating means if the individual transmission mode is set by said setting means.

Regarding claim 3, Kuwahara et al disclose an image reading apparatus according to claim 2, wherein said setting means (display 9, figure 6) includes initializing means for selectively designating either one of said serial transmission mode (“No” at decision box 406 of figure 4) and said individual transmission mode (selection of “NO” in 9d of figure 6) in response to a manipulation by the user as an initialization item with respect to the image reading apparatus.

Regarding claim 4, Kuwahara et al disclose an image reading apparatus according to claim 2, wherein said setting means includes an intermediate designating means for selectively designating either one of said serial transmission mode (“No” at decision box 406 of figure 4)

and said individual transmission mode (selection of “NO” in 9d of figure 6) in response to a manipulation by the user each time the image data is sent by said transmitting means.

Regarding claim 5, Kuwahara et al disclose an image reading apparatus according to claim 2, wherein said setting means includes switching means for switching (switch between “YES” and “NO” to designate batch or individual transmission modes in 9b of figure 6) over the transmission mode of the image reading apparatus between said serial transmission mode and said individual transmission mode in response to a manipulation by the user, and wherein said switching means is provided in an operation area (display 9, see figure 6) of the operating means, said operation area including an operation region different from a region for designating other items for transmission.

Regarding claim 6, Kuwahara et al disclose an image reading apparatus according to claim 5, wherein said operating means is adapted to display an operation screen in correspondence to said operation region (see switch area 9d of figure 6, col. 5, lines 45-47), and wherein said switching means is adapted to selectively display, in a title region of said operation screen, either one of said serial transmission mode and said individual transmission mode, as a currently operative transmission mode in the image reading apparatus.

Regarding claim 7, Kuwahara et al disclose an image reading apparatus according to claim 1, further comprising user identifying means (selection screen 9a; user can input confidential transmission ID and password which reads on a registered user of the system, col. 5, lines 5-12) for identifying the user of the image reading apparatus among a plurality of registered users (inherent since a user ID and password are necessary to use the system) in response to a manipulation by the user, wherein said transmitting means sends, after identifying the user by said user identifying means, plural image data corresponding to plural document sets read by said reading means serially (real-time transmission where each page of the

documents (i.e., plural image data) are scanned and immediately delivered to a recipient, see at least col. 1, lines 52-54) designated by said recipient designating means in said serial transmission mode.

Regarding claim 8, Kuwahara et al disclose an image reading apparatus according to claim 1, further comprising user identifying means (selection screen 9a to input user ID in 501 of figure 5) for identifying the user of the image reading apparatus among a plurality of registered users in response to a manipulation by the user, wherein said recipient designating means stores information relating to said user and the recipient (selection screen 9a showing recipients and fax numbers in figure 6) of the image data designated by said user in correlation to each other to allow the user to designate the recipient in correlation to the user identified by said user identifying means as the recipient of said image data.

Regarding claim 9, Kuwahara et al disclose an image reading apparatus according to claim 1, further comprising:

user identifying means (selection screen 9a to input user ID in 501 of figure 5) for identifying the user of the image reading apparatus among a plurality of registered users in response to a manipulation by the user, and

transmission completion notifying means (it was well-known in the art to set fax machines to store/print confirmation reports to ensure that a fax document has been transmitted) for storing information relating to said user and the recipient of the image data designated by said user in correlation to each other to send a notification, to the recipient in correlation to the user identified by said user identifying means, indicative of completion of transmission of the image data, in response to transmission of the image data by said transmitting means.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS J. LETT whose telephone number is (571)272-7464. The examiner can normally be reached on 8-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

/Thomas J. Lett/
Examiner, Art Unit 2625
/Edward L. Coles/
Supervisory Patent Examiner, Art Unit 2625